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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/916,578	08/22/97	CLARK	A 2553.004

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HM12/0418

EXAMINER

JOYNES, R

ART UNIT

PAPER NUMBER

1615

DATE MAILED:

04/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

08/916,578

Applicant(s)

CLARK ET AL.

Examiner

Robert M. Joynes

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Examiner would like to draw to applicants' attention to the absence of a statement according to 37 CFR 3.73(b) which requires an assignee seeking to take action in a matter before the Office with respect to a patent application to establish its ownership of the property. 37 CFR 3.73(b).

Examiner would also like to note that the Amendment to Claim 4 in applicants' Response to Office Action filed one June 12, 2001 was not properly submitted pursuant to 37 CFR 1.121(b). It is suggested that Applicants' cancel Claim 4 and submit a new Claim 14 with all the limitations of the improperly amended Claim 4 filed in the stated Response in the proper form pursuant to 37 CFR 1.121(b).

### ***Reissue Applications***

Claims 1-13 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35

U.S.C. 251 and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Applicants are seeking a reissue of U.S. Patent Number 5,443,833 issued on August 22, 1995. U.S. Patent Number 5,443,833 contains Claims 1-3, which are drawn to a method of treating a reversible obstructive airway disease. The instant reissue application contains the same three claims as well as Claims 4-13. Claims 4-13 were present in the prosecution of the original application but were cancelled after a final rejection filed February 13, 1995. The scope of the Claims 4-13 is broader than Claims 1-3 being that Claims 4-13 are drawn to methods of treating conjunctivitis, keratitis, allergic eyes and anterior uveitis. These claims are drawn to subject matter that was surrendered during the original prosecution of the application.

Applicants' understanding of these facts is evidenced in their Reissue Declarations filed with the instant application, more specifically in Paragraphs 7 and 8 of the Declarations. Therefore, Claims 1-13 cannot be allowed in the instant reissue application because the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Joynes whose telephone number is (703) 308-8869. The examiner can normally be reached on Monday through Friday 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Robert M. Joynes  
Patent Examiner  
Art Unit 1615  
April 13, 2001

THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
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